



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/825,931 | 04/05/2001 | Kimikazu Nagase | 360842007600 | 3818 |

25227 7590 03/10/2003

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

WALKE, AMANDA C

ART UNIT PAPER NUMBER

1752

DATE MAILED: 03/10/2003

4

Please find be' and/or attached an Office communication concerning this application or proceeding.

mk-4

Office Action Summary

Application N .

09/825,931

Applicant(s)

NAGASE ET AL.

Examiner

Amanda C Walke

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because in line 1, "plates" should be "plate". Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: On page 49, line 21, "toluen~~e~~" should be "toluene".

Appropriate correction is required.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al (EP 897795).

Ichikawa et al disclose a method of directly manufacturing a waterless lithographic printing plate comprising the steps of providing a support having coated thereon a thermosensitive layer and a silicon rubber layer, exposing the plate with laser beams and developing it (removing the imaged portions of the layer). The thermosensitive layer comprises dyes that absorb infrared or near-infrared light. The dyes should have a maximum absorption in the 400 to 1200 nm range, preferably the 700 to 900 nm range (page 3, line 42 to page 4, line 4).

Art Unit: 1752

After exposure, the plate undergoes development, which is preferably includes dyeing with a dyeing solution comprising a visible dye (page 12, line 45 to page 13, line 15). In the examples of the reference, the dyeing solution comprises 0.2 % by weight of the visible dye. The dyes listed by the reference, Crystal Violet and Victoria Pure Blue, are specifically mentioned as being preferred by the present application. The reference further teaches that there is an after-treatment step of dyeing to aid in the confirmation of the image area formed by the development. After dyeing, the heat sensitive layer surface is evaluated by observing visually the condition of the dyed layer's image/non-image area boundary.

With respect to the present claim limitation requiring that the difference between the reflected absorption of the non-printing area which holds the ink-repelling layer and the reflected absorption of said printing area observed after dyeing of the printing plate at the absorption maximum wavelength of the dye in said dyeing solution is not less than 0.3 and not more than 2.0, the limitation requiring that the maximum dye absorption be within a certain range, and to the limitation requiring that that ratio A/B be a certain value, it is the position of the examiner that since the material of the reference comprises the same dyes having wavelengths within the preferred range of the present application, is dyed employing visible dyes taught by the present specification as being suitable for use in the invention of the reference, and appears to be made using the same method steps, that when made, the printing plate of the reference would inherently possess the presently claimed properties, especially given that the reference teaches that the image area/ non-image area boundary is able to be observed visually after dyeing.

With respect to the limitations of the method claims that contain the phrase "observed by the reflection method" or "observed by the transmission method", these are not positive method

Art Unit: 1752

steps. These claims are claiming a method of manufacturing a printing plate which when made possesses certain properties that is desired may be observed by these methods and not actually adding a method step of observing the plate using either the transmission or reflection method. These claims are rejection under 102(b) for the reasons above.

Conclusion

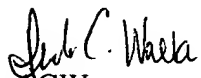
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ichikawa et al (JP 11-227352 and 6,194,122) are cited as being in the same patent family as the EP document relied upon above. Ichikawa et al (6,284,433, JP 2000-275824, and EP 1038669) are cited for being cumulative to the reference relied upon above. Yanagida et al (6,096,476) is cited for teaching a similar material and method, however, the material does not contain IR sensitive dyes as taught by the present application. The reference specifically requires the use of carbon black, whereas the present application does not mention carbon black as an additive, and only mentions infrared sensitive dyes as the light to heat converting agents. Tsuboi et al (3,901,706) is cited for its teaching of a photo-plate making process which includes the dyeing of the developed plate. The plate being made is not a direct-waterless plate, and contains silver nuclei for diffusion transfer, which is quite different than the presently claimed plate. Also, the dyes employed are not those mentioned as suitable for use in the instant invention. Yoshida et al (4,959,296) discloses a similar plate, but only generically mentions that the plates may be dyed, and fails to teach or suggest amounts or use them in examples.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

Art Unit: 1752

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


ACW

February 27, 2003

Amanda C Walke
Examiner
Art Unit 1752


JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700